

### **REMARKS**

Claims 1-3, 6-12, 17-22, 25-31, 36-40, 42, 43, 45 and 46 are all the claims pending in the application.

#### **I. Claim Rejections under 35 U.S.C. § 112, second paragraph**

Claims 1-3, 6-12, 17-22, 25-31, 36-40, 42, 43, 45 and 46 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

In particular, the Examiner indicated that in claims 1 and 2, the space formed by the cavity part “cannot perform a B/F separation of the marker reagent” (see Office Action at page 2). In response, Applicants point out to the Examiner that claims 1 and 2 did not indicate that the cavity part itself performs a B/F separation. Instead, claims 1 and 2 indicated that the volume of the cavity part is set so as to enable execution of B/F separation.

Nonetheless, in an effort to expedite prosecution, Applicants have amended claims 1 and 2 in a manner to more clearly define the invention. In particular, Applicants note that claims 1 and 2 have been amended to recite that an amount of inspection target solution regulated by the volume of the cavity part is the amount which makes the marker reagent in the reagent immobilization part B/F separated in a process of the inspection target solution being permeated into the development layer during a measurement.

Applicants respectfully submit that when read in light of the specification, one of ordinary skill in the art would readily be able to ascertain the meaning of the above-noted feature recited in claims 1 and 2. Accordingly, Applicants kindly request that the above-noted rejection under 35 U.S.C. 112, second paragraph be reconsidered and withdrawn.

## **II. Claim Rejections under 35 U.S.C. § 103(a)**

A. Claims 1-3, 10, 11, 17-22, 29, 30 and 36-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya et al. (EP 1 003 038) in view of Wenz et al. (U.S. 3,715,192).

Claims 1 and 2, as amended, recite that an amount of inspection target solution regulated by the volume of the cavity part is the amount which makes the marker reagent in the reagent immobilization part B/F separated in a process of the inspection target solution being permeated into the development layer during a measurement. Applicants respectfully submit that the combination of Nakaya and Wenz does not disclose or suggest such a feature.

With respect to the above-noted "cavity part" as recited in claims 1 and 2, the Examiner has recognized in the Office Action that Nakaya does not disclose or suggest such a feature. In an attempt to cure this deficiency, however, the Examiner has applied the Wenz reference.

Regarding Wenz, Applicants note that this reference discloses an indicator strip in which a cover film 3 is disposed so as to form a hollow space 4 between a capillary material 1 and the cover film 3 (see Fig. 1 and col. 5, lines 21-26). As explained in Wenz, the indicator strip having the hollow space 4 is immersed in a liquid to be tested, and color changes caused after a period of time are noted and/or compared to a color scale (see col. 7, lines 6-9).

Based on the foregoing description of Wenz, Applicants respectfully submit that while Wenz discloses the use of a cover film 3 that forms a hollow space 4, that the hollow space 4 of Wenz is not formed such that an amount of inspection target solution regulated by the volume of the hollow space 4 is the amount which makes a marker reagent in a reagent immobilization part B/F separated in a process of the inspection target solution being permeated into a development layer during a measurement.

In view of the foregoing, Applicants respectfully submit that the cited prior art does not disclose, suggest or otherwise render obvious at least the above-noted feature recited in amended claims 1 and 2 which recites that an amount of inspection target solution regulated by the volume of the cavity part is the amount which makes the marker reagent in the reagent immobilization part B/F separated in a process of the inspection target solution being permeated into the development layer during a measurement. Accordingly, Applicants submit that claims 1 and 2 are patentable over the combination of Nakaya and Wenz, an indication of which is kindly requested.

If the Examiner disagrees and believes that the hollow space 4 of Wenz is formed such that the above-noted feature recited in claims 1 and 2 is inherently disclosed in Wenz, then Applicants request that the Examiner provide a basis in fact and/or technical reasoning to reasonably support the determination that the above-noted feature recited in claims 1 and 2 necessarily flows from the disclosure of Wenz. See MPEP § 2112 (IV).

Claims 3, 10, 11, 17-21, 42 and 43 depend from claim 1, and claims 22, 29, 30, 36-40, 45 and 46 depend from claim 2. Accordingly, Applicants submit that these claims are patentable at least by virtue of their dependency.

B. Claims 6 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya et al. in view of Wenz et al., and further in view of Bernstein et al. (U.S. 5,824,268).

Claim 6 depends from claim 1, and claim 25 depends from claim 2. Applicants respectfully submit that Bernstein fails to cure the deficiencies of Nakaya and Wenz, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 6 and 25 are

patentable at least by virtue of their dependency.

C. Claims 7, 12, 26 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya et al. in view of Wenz et al., and further in view of Killeen et al. (U.S. 5,166,051).

Claims 7 and 12 depend from claim 1, and claims 26 and 31 depend from claim 2.

Applicants respectfully submit that Killeen fails to cure the deficiencies of Nakaya and Wenz, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 7, 12, 26 and 31 are patentable at least by virtue of their dependency.

D. Claims 8 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya et al. in view of Wenz et al., and further in view of Barr (U.S. 4,252,538).

Claim 8 depends from claim 1, and claim 27 depends from claim 2. Applicants respectfully submit that Barr fails to cure the deficiencies of Nakaya and Wenz, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 8 and 27 are patentable at least by virtue of their dependency.

E. Claims 9 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakaya et al. in view of Wenz et al., and further in view of Allen et al. (U.S. 5,416,000)

Regarding claims 9 and 28, Applicants note claim 9 depends from claim 1 and that claim 28 depends from claim 2. Applicants respectfully submit that Allen fails to cure the deficiencies of Nakaya and Wenz, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claims 9 and 28 are patentable at least by virtue of their dependency.

### **III. Double Patenting**

Claims 1-3, 6-12, 17-22, 25-31 and 36-46 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/069,845 in view of Wenz et al. (U.S. 3,715,192) Applicants note that the Examiner also identifies Application Nos. 10/133,698, 10/398,711, 10/048,727, 10/116,407 and 10/242672 and asserts that these applications would also require similar provisional obviousness-type double patenting rejections as set forth for Application No. 10/069,845.

As the above-noted rejection of claims 1-3, 6-12, 17-22, 25-31 and 36-46 under obviousness-type double patenting is provisional, Applicants hereby request that the rejection be held in abeyance. If the provisional double patenting rejection is the only remaining rejection in the application, Applicants will file a terminal disclaimer, if necessary, to overcome such a rejection. See MPEP 804(I)(B).

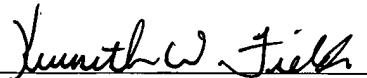
### **IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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